



DOCKET NO: 202708US6

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

TSUNETAKE NOMA : EXAMINER: LEE, P.
SERIAL NO: 09/684,063 :
FILED: OCTOBER 6, 2000 : GROUP ART UNIT: 2154
FOR: SERVICE PROVIDING :
APPARATUS AND METHOD, AND :
INFORMATION PROCESSING :
APPARATUS AND METHOD AS WELL :
AS PROGRAM STORAGE MEDIUM :

REMARKS ACCOMPANYING
PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicant respectfully requests that a Pre-Appeal Brief Conference be initiated in accordance with the pilot program outlined in the Official Gazette Notice of July 12, 2005.

FAILURE TO PRESENT A *PRIMA FACIE* CASE OF OBVIOUSNESS

Applicant submits that the Official Action of May 24, 2005 has failed to provide a *prima facie* case of obviousness with respect to any of Claims 1-9 under 35 U.S.C. §103.¹

- Pending Claims 1-9 stand rejected under 35 U.S.C. §103 as unpatentable over Agraharam in view of Porter. As outlined in detail in the response filed August 24, 2005, this rejection is deficient in that neither reference provides any discussion relative to an entire

¹See Official Action of May 25, 2005 detailing the rejection of Claims 1-9 under 35 U.S.C. §103 as unpatentable over Agraharam et al. (U.S. Patent No. 5,956,482, hereinafter Agraharam) in view of Porter et al. (U.S. Patent No. 6,675,299, hereinafter Porter).

element of the Applicants' claims. Further, there is no motivation to combine the cited references, as Porter is not analogous to the invention recited in Claim 1.

Independent Claim 1 recites, *inter alia*, "reception means ... for receiving a content request transmitted from any of the information processing apparatuses belonging to one of the plurality of groups, ***the content request including a selection from the list of available content.***" (Emphasis added).

As discussed in detail in the response filed August 24, 2005, Agraharam does not teach or suggest this claim element. In response to this assertion, the Advisory Action provided the following explanation:

Agraharam further taught the request ... could be sent by members of the session audience (page 4, paragraph 38).²

Paragraph 38 of Agraharam describes that session members may request an audio link to allow them to hear the audio content corresponding to the multimedia content ***selected by the session conductor.*** As described in paragraph 27 of Agraharam, only the session conductor can select multimedia documents to be pushed to other users. Consequently, the request for an audio link cited in the Advisory Action does not include "a selection from the list of available content," as recited in Claim 1. Accordingly, Agraharam does not teach or suggest "reception means," as recited in Claim 1. As it is well settled that all claim limitations must be taught or suggested by the cited art (See *In re Royka*, 180 USPQ 580 (C.C.P.A. 1974)), a *prima facie* case of obviousness has not been established for Claim 1. Consequently, it is respectfully submitted that Claim 1 (and Claims 2 and 3 dependent therefrom) is patentable over the cited references.

As discussed in the response filed August 24, 2005, independent Claims 4, 5, 6, 8, and 9 recite similar elements to Claim 1. Accordingly, it is respectfully submitted that Claims 4,

²See Advisory Action of September 14, 2005, paragraph 3.

5, 6, 8, and 9 (and Claim 7 dependent therefrom) are patentable over the cited references for at least the reasons discussed above with respect to Claim 1.

CONCLUSION

Based on this clear legal deficiency in the above-noted rejection, Applicants respectfully request that prosecution be re-opened.

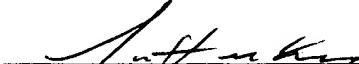
Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)



Bradley D. Lytle
Registration No. 40,073
Scott A. McKeown
Registration No. 42,866